

Thus, the Applicants respectfully submit that Figs. A-C are indeed factual evidence on this record and by definition must be considered.

The rejection also deems the Applicants' arguments insufficient because the "scope of Kawabata is not limited to the specific embodiments it teaches" in the context of the Applicants' identification of certain aspects of Kawabata and distinguishing over them. The Applicants agree with the overall concept that a disclosure is not limited to specific embodiments or specific examples. The prior art must be taken as a whole. However, there are two additional compelling points in this respect. The scope of a publication taken "as a whole" is established through the individual components of the overall disclosure. Thus, it is entirely appropriate to identify specific embodiments and/or examples as representative of what the teachings of a publication are as a whole.

Further, the Applicants respectfully submit that it is impermissible for the rejection to reject an argument because the Applicant is relying on specific embodiments when the rejection itself is based on specific embodiments. In that regard, the rejection specifically states that Kawabata teaches "a specific example" which is used as a basis for rejecting the Applicants' claims. The rejection cannot have it both ways. It cannot rely on specific examples on the one hand and then prevent the Applicants from utilizing specific examples on the other hand. The Applicants thus respectfully submit that the rejection is flawed in this regard.

In any event, and irrespective of all of the above, the Applicants respectfully submit that Figs. A-C, which are factual evidence on this record, demonstrate unexpected results to those skilled in this art. In that regard, the rejection states that the claimed amounts of precipitated W and associated physical characteristics would be inherently present. The problem with this position is that it is incorrect. The Applicants have taken the single example in Kawabata that is available to the

Applicants and demonstrated that the amount of precipitated W, when within the Applicants' claimed range, results in a steel which does not have the claimed physical characteristics. Thus, while the rejection is based on speculation, the Applicants' rebuttal is based on an actual fact on the record. This can be seen in Figs. A and B.

Reference to all of these figures readily shows at a quick glance that there are unexpected results. In that regard, Fig. A shows a very clean "box" in the upper left-hand corner which frames a very consistent relationship between the amount of added W and precipitated W. The Applicants also note that despite the alleged inherency of the amount of precipitated W being within the Applicants' claimed range as set forth in the rejection, the Kawabata example is actually outside of the Applicants' claimed range. This completely rebuts the position taken in the rejection.

Referring to Fig. B, this graph shows a very unexpected result simply by glancing at the figure. The points within the claimed range are a sharp departure from the other points which show a relative flat line, which, when moving from left to right, dramatically and rapidly "drop" thereby demonstrating a classic case of an unexpected phenomenon where a relatively flat line becomes almost vertical in a very short space.

Fig. C is similar in that regard wherein a number of data points are tightly packed together and then rapidly changed over a small change in components.

When this information is taken in the context of the disclosure of Kawabata, these results would be completely unexpected to one skilled in the art. This is particularly true given the lack of disclosure with respect to W. This is particularly compelling given that one example out of over a 100 examples in the Kawabata disclosure make any reference to W at all. How would one skilled in the art have any expectations associated with the presence of W based on a single example out of

100? (This is particularly true when the Applicants' facts have demonstrated that the one example is outside of the Applicants' claimed range.)

Also, the specific examples referred to in the rejection are simply inapplicable to the Applicants' steels because that example (which is described in the rejection as spanning columns 13 and 14), does not include any example having W at all. That example is completely devoid of cold rolled sheets having any W content. Thus, to the extent that there could be overlap in the process for making the steels in the example spanning columns 13 and 14, those examples do not contain any W. In sharp contrast, the single sample containing W is described in the context of a different process which applies to the text in column 10 beginning at line 41. Therefore, the rejection mixes "apples and oranges."

As a result, the Applicants respectfully submit that Kawabata is inapplicable to all of Claims 13-17, 20 and 21 under 35 USC §103. Withdrawal of the rejection is respectfully requested.

Claims 13-17, 20 and 21 stand rejected on the grounds of nonstatutory obviousness-type double patenting over Claims 1-8, 10-14 and 16 of US Patent No. 7,806,993 in view of Kawabata. Given the inapplicability of Kawabata as set forth above, the Applicants respectfully submit that its combination with US Patent No. 7,806,993 would still result in completely different subject matter which does not constitute double patenting. Withdrawal of the rejection is respectfully requested.

In light of the foregoing, the Applicants respectfully submit that the entire application is now in condition for allowance, which is respectfully requested.

Respectfully submitted,


T. Daniel Christenbury
Reg. No. 31,750
Attorney for Applicants

TDC/vp
(215) 656-3381